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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,970	04/27/2001	James Savoie	P-3032.01(UTI)	1652
7590	03/05/2004		EXAMINER	NGUYEN, MERILYN P
Cline H. White JACKSON WALKER, LLP 112 E. Pecan, Suit 2100 San Antonio, TX 78205			ART UNIT	PAPER NUMBER
			2171	13
DATE MAILED: 03/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/844,970	SAVOIE ET AL.
Examiner	Art Unit	
Merilyn P Nguyen	2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 12/05/2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 1-14 and 16-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 3,4,7,8,13,14 and 16 is/are allowed.

6)  Claim(s) 1,2,5,6,9-12 and 17-20 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 29 April 2001 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All    b)  Some \* c)  None of:

  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: Detailed Action.

**DETAILED ACTION**

1. This application claims benefit of 60/200,784 filed on April 28, 2000.
  
2. In response to the communication dated 12/05/ 2003, claims 1-14 and 16-20 are active in this application as the result of the cancellation of claim 15, and the addition of claims 17-20.

*Acknowledges*

3. Receipt is acknowledged of the following items:
  - o The applicant amendment has been considered and made of record as Paper No. 12.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 10, lines 10-12 and claim 11, lines 14-15, there is insufficient antecedent basic for "said selected records".

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 5, 9-11, 17, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Mezei (US 6,070,175).

Regarding claims 1 and 17, Mezei discloses a method for creating a computer file readable by a pagination program for generating an output (See Figs. 2, 53, and 55), comprising:

- ❖ accessing a computer database (See Col. 6, lines 19-39);
- ❖ identifying a record stored in said computer database (See col. 6, lines 40-47);
- ❖ adding a field directive to said record, wherein said field directive contains an instruction to said pagination program directing how said pagination program will format said output (See col. 28, lines 21-36, and col. 30, lines 13-22);
- ❖ retrieving said record from said computer database (See Fig. 3);
- ❖ adding computer code to said record to create said computer file, wherein said computer code makes said computer file readable by said pagination program (See col. 28, lines 55-65, and col. 29, lines 30-51); and
- ❖ transferring said computer file to said pagination program where said output can be generated, wherein said output is a printed document (output file 938, Fig. 53, and corresponding text).

Regarding claims 5 and 19, Mezei discloses computer program having control logic stored therein, said control logic, when executed, enabling a computer to generate a computer file containing a record received from a computer database, add a field directive to said computer file, and convert said computer file to be compatible with a pagination program to develop an output (See Figs. 2, 53, and 55), said control logic comprising:

- ❖ accessing means for enabling said computer to access said record from said computer database (See Col. 6, lines 19-39);
- ❖ coding means for identifying said record contained in said computer database (See col. 6, lines 40-47);
- ❖ coding means for adding at least one field directive, wherein said field directive provides an instruction to said pagination program directing how said pagination program will format said output (See col. 28, lines 21-36, and col. 30, lines 13-22);
- ❖ coding means for converting said record into a computer file readable by said pagination program (See col. 29, lines 1-3, and col. 30, lines 13-14); and
- ❖ coding means for transferring said computer file to said pagination program (output file 938, Fig. 53, and corresponding text).

Mezei further discloses wherein said output is a printed document (output file 938, Fig. 53) as recited in claim 19.

Regarding claim 9, Mezei discloses a method for converting at least two records stored in a computer database into a computer file readable by a pagination program, by:

- ❖ finding and retrieving a first record and a second record, each contained in said computer database (See Col. 6, lines 19-39);
- ❖ adding a first field directive to said first record and a second field directive to said second record that will act as instructions to said pagination program to create a desired output (See col. 28, lines 21-36, and col. 30, lines 13-22);
- ❖ generating said computer file from said records (MIF files, See col. 30, lines 13-22);
- ❖ adding computer code to said computer file so as to make said computer file readable by said pagination program (See col. 6, lines 6-17); and
- ❖ transferring said computer file to said computer pagination program (output file 938, Fig. 53, and corresponding text).

Regarding claim 10, Mezei discloses a computer-readable medium containing instructions for controlling a computer system for converting at least two records stored in a computer database into a computer file readable by a pagination program, by:

- ❖ using instructions in said computer readable medium to control said computer system to find and retrieve said records contained in said computer database to be converted into said computer file readable by said pagination program (See Col. 6, lines 19-39);
- ❖ adding computer code to said records in order that said computer file will have a desired output (See col. 6, lines 6-17);

- ❖ generating said computer file from said records (MIF files, See col. 30, lines 13-22);
- ❖ analyzing said selected records to determine when all said selected records have been obtained from said computer database (See col. 7, lines 21-32); and
- ❖ when it is determined all selected records have been obtained, exporting said computer file to said computer pagination program (pagination commands, Fig. 26, and corresponding text).

Regarding claim 11, Mezei discloses an article of manufacture comprising:

- ❖ a computer useable medium having computer readable program code means embodied therein for converting information stored in a computer database into a computer file readable by a computer pagination program (See col. 29, lines 1-3, and col. 30, lines 13-14), the computer readable program code means in said article of manufacture comprising:
- ❖ computer readable program code means for causing the selection of the records contained in said computer database to be converted (See Col. 6, lines 19-39);
- ❖ computer readable program code means for causing the sampling said computer database a number of times to obtain said selected records (See col. 7, lines 21-32);
- ❖ computer readable program code means for causing the adding of computer code to said records in order that said computer file will have a desired output (See col. 6, lines 6-17);

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- ❖ computer readable program code means for causing the generation of said computer file from said records (MIF files, See col. 30, lines 13-22);
- ❖ computer readable program code means for causing the analyzing of said selected records to determine when all said selected records have been obtained from said computer database (See col. 7, lines 21-32); and
- ❖ computer readable program code means for causing the exportation of said computer file to said computer pagination program (pagination commands, Fig. 26, and corresponding text).

6. Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by Warmus (US 6,332,149).

Regarding claim 12, Warmus discloses a method of converting a record of a first product stored in a computer database into a computer file readable by a pagination program (See col. 3, lines 31-60), comprising:

- ❖ controlling a computer system to create a file template (Template files, Fig. 5, and Fig. 9, and Col. 11, lines 52-61);
- ❖ controlling said computer program to select said record of said first product from among multiple product records stored in said computer database (See col. 16, lines 27-52);
- ❖ using said file template to add a field directive to said record of said first product, said field directive containing instructions used by said pagination program for formatting an output (See col. 12, lines 48-62);

- ❖ adding computer code to said record of said first product in order to create a computer file that is readable by said pagination program (See Fig. 11, and col. 20, lines 17-35); and
- ❖ transferring said computer file to said pagination program (See Fig. 12, and col. 20, lines 55-59).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 6, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mezei (US 6,070,175), in view of Sutcliffe (US 6,253,216).

Regarding claims 2, 6, 18, and 20, Mezei discloses all the claimed subject matter as set forth above; however, Mezei is silent as to identifying a first recipient of said output;

- ❖ obtaining said first recipient's address information;
- ❖ determining if said first recipient has a characteristic, said characteristic consisting of at least one of a bad account, a closed account, a competitor, a prior recipient, a non-orderer, or an undesirable physical location;
- ❖ terminating transfer of said output to said first recipient at said address if said first recipient has said characteristic; and

- ❖ transferring said output to said first recipient if said first recipient does not have said characteristic.

On the other hand, Sutcliffe discloses identifying a first recipient of said output (See col. 3, lines 64-65, Sutcliffe et al.);

- ❖ obtaining said first recipient's address information (See col. 4, lines 1-5, Sutcliffe et al.);
- ❖ determining if said first recipient has a characteristic, said characteristic consisting of at least one of a bad account, a closed account, a competitor, a prior recipient, a non-orderer, or an undesirable physical location (See col. 10, lines 32-37);
- ❖ terminating transfer of said output to said first recipient at said address if said first recipient has said characteristic (166, Fig. 4, and corresponding text); and
- ❖ transferring said output to said first recipient if said first recipient does not have said characteristic (168, Fig. 4, and corresponding text).

Because Mezei system having a pagination program to generate output to users, it would have been obvious to one having ordinary skill in the art at the time the invention was made to terminate transferring or permit transferring output from pagination program, as suggest by Sutcliffe, in term of security. The motivation would have been to weed out illegible recipient.

***Allowable Subject Matter***

8. Claims 3, 7, 13, 16, are allowed. The reasons for allowance are stated in the previous Office Action mailed July 7, 2003 (Please see Paper No. 8).

Claims 4, 8, and 14 are allowable because they are dependent on allowable claims.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-14 and 16-20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

De Heus U.S Patent No. 5,390,354 discloses computerized directory pagination system and method.

Rivette U.S Patent No. 6,018,749 discloses system, method, and computer program product for generating documents using pagination information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 703-305-5177. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MW

MN

February 23, 2004



SAFET METJAHIC  
SUPERVISORY PATENT EXAMINER  
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